

REMARKS

Claims 23-31 and 34-42 are pending in the application. Claims 1-22 and 32-33 were previously canceled, without prejudice, as being directed to a non-elected invention subject to restriction. Claims 23-31 and 34-40 are subject to restriction in the current action. The applicant respectfully traverses the restriction requirement.

Claim 31 is amended to depend from claim 24, elected in this response, and new claims 41 and 42 are added dependent upon claim 34. The original subject matter of claim 31 is not abandoned, and the applicant reserves the right to bring claims of the same or similar scope as claim 31 in this or later applications.

The action states restriction is appropriate because Group I, claims 23-30 and 34-40 are drawn to an assembly of an electrical device, while claim 31 is drawn to a receiver, a product made using the assembly. In this regard the inventions I and II are related as apparatus and product made, but are alleged to be distinct because the claimed apparatus can be used for making a materially different product, such as a printed circuit board, as opposed to a receiver. The action then concludes restriction is appropriate because the inventions are said to have acquired separate status in the art because of their recognized divergent subject matter. Yet the action cites neither the knowledge possessed by a person having ordinary skill in the art nor any publication to support these allegations. Nor does the action explain how a linkage assembly, essentially a mechanical device, can be used in a printed circuit board.

Traverse of the Restriction Requirement

By imposing restriction among the two groups of claims, the U.S. Patent and Trademark Office ("PTO") makes numerous admissions that may compel it to issue at least two separate patents. Specifically, if the two-way restriction requirement is maintained, then the PTO admits that the Group I assembly is patentable over a disclosure of the Group II product containing the Group I assembly, and vice versa. See, e.g., MPEP § 802.01 (8th Ed., Rev. 3, Aug. 2005). These admissions are necessary to the PTO's entry of the restriction requirement and may be relied upon by the applicant during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the

PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

The restriction requirement also should be withdrawn because the restriction may present potential double patenting. According to the MPEP, the patent statute (e.g., 35 USC § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a **heavy burden** on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

See MPEP § 804.01 (8th Ed., Rev. 3, Aug. 2005) (emphasis added). The applicant respectfully requests reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

According to the MPEP, a requirement for restriction between multiple inventions is proper only when the PTO establishes (1) that the claimed inventions are independent or distinct, and (2) there would be a serious burden on the examiner if restriction were not required:

If the search and examination of all the claims in an application can be made without serious burden, **the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.**

MPEP § 803 (8th Ed., Rev. 3, Aug. 2005) (emphasis added).

The applicant acknowledges that “a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02 [(8th Ed., Rev. 3, Aug.

2005)].” MPEP § 803(II). However, in the instant case, any *prima facie* showing of serious burden is rebutted because the search of one group will include a search of another group. *Id.* (stating that a “*prima facie* showing [of serious burden] may be rebutted by appropriate showings or evidence by the applicant”).

The claims of Groups I and II are concerned with and recite related subject matter; specifically in that Group I recites components that may be used in a receiver assembly while Group II claims a receiver incorporating such components. The subject matter recited in all of the pending claims is sufficiently similar such that a complete search directed to the Group I assembly and the Group II product would include a search directed to the assembly of Group I and receivers of Group II, and vice versa.

Because search and examination of the Group I and II can be performed without serious burden on the PTO, requiring the applicant to prosecute those claims in separate patent applications would waste the time, effort, and resources of both the applicant and the PTO. Furthermore, the applicant will likely incur additional prosecution costs associated with filing multiple divisional applications and the PTO will be required to perform duplicative searches if the restriction requirement is maintained. Thus, withdrawal of the restriction requirement relative to Groups I and II will actually reduce the burden on the PTO and on the applicants.

In view of the foregoing, the applicant respectfully requests reconsideration and withdrawal of the restriction requirement imposed between the claims falling within Groups I and II.

Provisional Election

Applicant hereby provisionally elects the claims of Group I. Claim 31 being amended and claims 41 and 42 being newly added are believed to fall within the elected invention.

Favorable consideration of claims 23-32 and 34-42 is respectfully requested.

Application No. 10/719,765
Amendment dated August 10, 2006
Reply to Restriction Requirement dated July 7, 2006

Docket No.: 30521/3056

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: August 10, 2006

Respectfully submitted,

By /Anthony G. Sitko/

Anthony G. Sitko

Registration No.: 36,278

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant